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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,398	01/27/2000	Al J. Mooney		9822

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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,398

Applicant(s)

MOONEY, AL J.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 32-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**SAM RIMELL
PRIMARY EXAMINER**

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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Claims 32-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 32: The phrase “the transaction” lacks antecedent basis and is also indefinite. It is not clear whether “the transaction” refers to the prescription by the provider or the ordering of the medical supply.

Claim 34: The phrase “the medical supply provider” lack antecedent basis. This also raises an issue of indefiniteness, since it is not clear whether this phrase is referring to the medical care provider or the medical supply vendor.

Claim 35: The phrase “the medical service vendor” lacks antecedent basis. This also raises an issue of indefiniteness, since it is not clear whether this phrase refers to the medical care provider or the medical supply vendor.

Claim 36: The phrases “the account of the medical service provider” and “the account of the medical service vendor” each lack antecedent basis. Note that claim 32 from which this claims depends does not define either “accounts” or a “medical service vendor”.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined

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was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 32-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Silver ('339).

Claim 32: FIG. 22 describes a website on the Internet (col. 8, lines 15-17). The website is established by a medical care provider (Dr. Michael Roizen, as seen in FIG. 2). The purpose of the website is twofold: (1) For facilitating a medical examination in the form of a health profile questionnaire (col. 9, line 42) presented to the user; and (2) For prescribing specific medical supplies that can be ordered by a user (col. 18, lines 55-68).

Once the medical examination (questionnaire) has been completed, the interface of FIG. 22 is presented, illustrating the conclusions of the medical examination. The user can then check a box (indicated by the check mark) which will produce a report indicating a URL for a medical supply vendor (col. 18, lines 61-63). The user can then redirect his/her computer to that supply vendor using the URL as the guide for locating the supply vendor's site. The user can then consummate a transaction with the medical supply vendor through the vendor's website or by placing a toll free telephone call. The e-commerce provider can be any server computer on the Internet, including the server which supports the website described by Silver (col. 7, line 61), or server computers that support the medical supply vendor.

The medical care provider receives payment through subscriptions for the service of providing the questionnaire and prescriptions resulting from the questionnaire. These services are the claimed "transactions".

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Claim 33: The examination is the questionnaire provided to the user and the diagnosis is the automated analysis performed which leads to the set of recommendations in FIG. 22. The recommendations of FIG. 22 become the prescription which the medical care provider orders for the patient.

Claim 34: The e-commerce providers are servers on the Internet which either support the website of Silver or the medical supply vendor (servers are described at col. 7, line 61 and are also inherent features of the Internet.). Given the lack of antecedence and indefiniteness in the claim, it is not clear who the e-commerce provider is making the accounting to. In Silver, the servers which support the website pass payments to the medical care provider (See block 112 in FIG. 1). Servers which support the medical supply vendor could inherently pass payments as well.

Claim 35: Given the lack of antecedence and indefiniteness, it is not clear who the e-commerce provider is supposed to be accountable to. See remarks for claim 34.

Claim 36: Given that the disclosure of Silver calls for a medical care provider and a medical supply vendor, each of which are paid for what they provide, it is inherent that each have an account to receive payments.

Claim 37: The website of Silver permits a user to gain access to medical supplies that correlate to a specific prescription for that user (col. 18, lines 55-57). The medical care provider acts as a participant in the sale by making a referral to the supply vendor.

Claim 38: A server which supports a website on the Internet can be considered a network gateway.

Remarks

Applicant's arguments have been considered but are not well taken. With respect to claim 32 in particular, applicant argues that Silver does not teach compensation to the medical care provider for consummating "the transaction". First, it is not clear in the claims whether "the transaction" is the purchase of the supplies or the act of prescribing for the medical supplies. Secondly, Silver is not lacking in teaching a payment for the medical care provider. As seen in FIG. 1, Silver does teach the medical care provider receiving payments for subscriptions to the website. This is the claimed compensation that the medical care provider receives for the transaction of preparing and providing a prescription for medical supplies.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.

A handwritten signature in black ink, appearing to read 'S. Rimell', written in a cursive style.

Sam Rimell
Primary Examiner
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